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In re Application of
Martinez-Gutierrez et al.
Serial Number:10/558,628
Filed: July 13, 2006
Attorney Docket No.:10451.204-US

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: PETITION DECISION
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This is in response to the petition under 37 CFR § 1.181, filed September 25, 2007, requesting withdrawal of finality of the Office action of July 27, 2007.

BACKGROUND

A review of the history of this case reveals that the examiner mailed a non-final Office action on December 18, 2006, setting a three month shortened statutory period for reply. In this Office action, claims 13-24 were pending. The examiner rejected claims 14-17, 21, 23 and 24 under 35 U.S.C. 112, Second paragraph for being indefinite, rejected claims 13-16 and 18-24 under 35 USC 103(a) as being unpatentable over LaRoye et al. (WO 97/42301) in view of Antrim (US 5,180,669) in view of Wang (2001) supported by Thompson (US 6,468,355) and rejected claims 17 and 21 under 35 USC 103(a) as being unpatentable over LaRoye et al. (WO 97/42301) in view of Antrim (US 5,180,669) in view of Wang (2001) supported by Thompson (US 6,468,355) and further in view of Kleman-Leyer et al. (1996).

In reply thereto, Applicants filed a response on May 17, 2007 which included an amendment canceling claims 13-24 and adding new claims 25-45. Applicants' response was accompanied by remarks and arguments.

The examiner mailed a final Office action on July 27, 2007. In this Office action, claims 25-45 were pending. The examiner rejected claims 25-45 under 35 USC 103(a) as being unpatentable over LaRoye et al. (WO 97/42301) in view of Antrim (US 5,180,669) in view of Silver (US 4,795,101) supported by Thompson (US 6,468,355). It is noted that the examiner's rejection commences with "Claims 25-28, 32 and 35-45 are rejected under 35 U.S.C. 103(a)...." (p. 2,

final Office action) which appears to omit claims 29-31 and 34 from the rejection. However, the examiner does state on page 6, at the end of rejection: "Therefore, the references listed above renders obvious claims 25-45." It is thus determined that the omission of claims 29-31 and 34 was a typographical error, as it is clear from the examiner's comments that the intent of the examiner was to include these claims in the rejection. Thus, any comments pertaining herein to claims which were finally rejected in the Office action of July 27, 2007 will be interpreted to mean 'the rejection of claims 25-45 under 35 USC 103(a) as being unpatentable over LaRoye et al. (WO 97/42301) in view of Antrim (US 5,180,669) in view of Silver (US 4,795,101) supported by Thompson (US 6,468,355).'

In response thereto, applicants filed this petition on September 25, 2007 requesting reconsideration and removal of the finality of the Office action of July 27, 2007.

DISCUSSION

Applicants argue that the final Office action of July 27, 2007 was premature as the amendment of May 17, 2007 is not believed to have necessitated the new grounds of rejection. More specifically, applicants argue that the Office action of July 27, 2007 contained a new grounds of rejection based on newly cited art; that is, the rejection of claims 25-45 under 35 USC 103(a) as being unpatentable over LaRoye et al. (WO 97/42301) in view of Antrim (US 5,180,669) in view of Silver (US 4,795,101) supported by Thompson (US 6,468,355).

Applicants argue:

Except for the elimination of step a recited in claim 13, the scope of claims 13 and 25 is identical. Furthermore, the absence of step (a) is not the reason that the new claims are subject to a new ground for rejection under 35 U.S.C. 103. Rather the 103 rejection set forth in the initial office action was withdrawn after Applicants argued that it was improper to combine Wang with the other cited references (Laroye et al., Antrim and Thompson et al.). Therefore, Applicants' amendment did not necessitate the new rejection.

It is noted that Applicants' assessment of the scope of claims 13 and 25 is accepted. In addition, another difference in scope between claims 25-45 and cancelled claims 13-24, is that claims 44 and 45 recite "The method of claim 25, wherein the saccharification and fermentation are performed as separate steps" and "The method of claim 25, wherein the saccharification and fermentation are performed simultaneously" respectively. These limitations were not present in canceled claims 13-24.

In the final Office action on July 27, 2007, the examiner withdrew the previous rejections and instituted a new rejection over claims 25-45 as being unpatentable over LaRoye et al. (WO 97/42301) in view of Antrim (US 5,180,669) in view of Silver (US 4,795,101) supported by

Thompson (US 6,468,355). With regard to the limitations present in claims 44 and 45, the examiner commented:

...LaRoy teach that their fermentation and saccharification are performed as separate steps. It would be obvious to one of ordinary skill in the art since the art has numerous teachings on converting stepwise fermentations to simultaneous saccharification and fermentation. Furthermore MPEP § 2144.04 V B, C, E, support that general statements making a process either separate, sequential or simultaneous is obvious (p. 5, final Office action).

Therefore, with regard to the new limitations found in claims 44 and 45, the examiner referred to the LaRoy et al. reference as well as the MPEP for support with regard to the rejection of these claims, but did not specifically add the Silver patent to the rejection to reject these claims.

With regard to the Silver patent, the examiner stated:

While both of the above references teach some type of pretreatment of to [sic] the mash LaRoye et al. teach the addition of a [sic] cellulases, β -glucanase, and α -amylase to hydrolyze the cellulose and start to make it more amorphous to improve enzyme access to the substrate. Antrim teach an acid hydrolysis process to make the substrate more amorphous. However, neither specifically teach a pretreatment of β -glucanase in the mash before jet-cooking. Regardless this would be obvious to one of ordinary skill in the art by the time the invention was made in view of the teachings of Silver.....Silver too uses cellulase enzymes to mill grains such as corn...Silver uses GENCORE CELLULASE 150 L to steep their corn kernels...before Jet Cooking...Silver teach that GENCORE CELLULASE 150 L contains both endoglucosidase and β -glucanase (p. 5, final Office action).

The examiner further commented that:

Since Silver already teach the addition of the endoglucanase before the gelatinization of the corn to the method it would be obvious to alter the sequence to add endoglucanase in the later steps or add more endoglucanase later in the absence of evidence of criticality to the contrary...(p. 6, final Office action).

The MPEP clearly states:

...second or any subsequent actions on the merits shall be final, *except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)....(MPEP § 706.07(a)) (emphasis added)*

It is apparent that the examiner has incorporated the Silver patent into the rejection under 35 USC 103(a) in order to place a new ground of rejection *over embodiments which were already present in the claimed invention prior to Applicants' amendments* to the claims on May 17, 2007.

Therefore, the new grounds of rejection made by the examiner in the final Office action issued July 27, 2007 *were not necessitated by Applicants' amendments to the claims.*

Applicants' arguments are persuasive that the final Office action issued July 27, 2007 was premature and the finality of the Office action will be withdrawn.

DECISION

The petition is **GRANTED.**

This application will be forwarded to the examiner for an action not inconsistent with this decision.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.

A handwritten signature in black ink, appearing to read 'Bruce Kisliuk', with a stylized flourish at the end.

Bruce Kisliuk
Director, Technology Center 1600